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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/068,253	06/09/1998	TAKESADA SHIMURA	146.1286	2129

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BIERMAN MUSERLIAN AND LUCAS  
600 THIRD AVENUE  
NEW YORK, NY 10016

EXAMINER

MOHAMED, ABDEL A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 08/27/2002

37

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/068,253

Applicant(s)

SHIMURA ET AL.

Examiner

Abdel A. Mohamed

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-5,8-11,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5,8-11,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 May 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1653

**DETAILED ACTION**

1. The Examiner in charge of this application has been changed. However, the Group and/or Art Unit location of your application in the PTO remains the same. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1653.

**CPA STATUS ACCEPTABLE**

2. The request filed on 5/21/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/068,253 is acceptable and a CPA has been established. An action on the CPA follows.

**ACKNOWLEDGMENT OF AMENDMENT AND RESPONSE, STATUS OF THE SPECIFICATION AND CLAIMS**

3. The amendment and response filed 5/21/02 are acknowledged, entered and considered. In view of Applicant's request the specification and claims 2, 8, 9 and 14 have been amended, and claim 13 has been canceled. Thus, claims 2-5, 8-11 and 14-15 are now pending in the application.

Art Unit: 1653

#### **OBJECTION TO THE ABSTRACT AND DRAWING**

4. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. Thus, Applicant should present an abstract limited to a single paragraph. With respect to the amendment of Figure 1 filed 5/21/02, the amendment to Figure 1 has been approved, however, Applicant has to provide Figure 1 as amended without the red markings along with the correction of the objected Figures as shown on the attached Form PTO-948.

#### **OBJECTIONS TO TRADEMARKS AND THEIR USE**

5. The use of trademarks "EXOCOPOL®" and "ADEKA®" have been noted in this application. Although, the use of trademarks are permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in a manner which might adversely affect their validity as trademarks.

Further, the specification which specifies the generic terminology should include published product information sufficient to show that the generic terminology or the generic description are inherent in the article referred by the trademarks. These description requirement are made because the nature and composition of articles denoted by trademarks can change and affect the adequacy of the disclosure.

Art Unit: 1653

**CLAIMS REJECTION-35 U.S.C. § 112<sup>2nd</sup> PARAGRAPH**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5, 8-11 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that Applicant has argued that a molecular weight is defined as the weight of a molecule resulting from the sum of the weight of all atoms having unit Dalton. If no unit indication is made, it is assumed that Dalton is meant, and as such, it is not necessary to include in the claim. However, it is the Examiner's position that if a unit in a claim is not defined, then the claim is indefinite because e.g., the molecular weights recited in claims 2, 8 and 14 could be in a unit of "Dalton (D)" or "kilo Dalton (kD)". Thus, to avoid confusion and make the claims clear, if "Dalton" not "kilo Dalton" is contemplated, then it is suggested that Applicant to amend the claims to such. Further, the method used to determine the molecular weight should be identified because the molecular weights observed may vary slightly depending on the techniques used in performing the analysis. Appropriate correction is required.

Claim 14 is indefinite in the recitation "...900 to 4000...". It is believed to be epigraphical error. Amendment of the claim to recite ".....900 to 4,000..." is suggested (See e.g. claim 2 and page 4, last paragraph of the instant specification for consistency).

Art Unit: 1653

Claim 15 is indefinite in depending upon canceled claim 13. Appropriate correction is required.

**CONCLUSION AD FUTURE CORRESPONDENCE**

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

*Amy* Mohamed/AAM

August 26, 2002

*Abdel A. Mohamed*  
ABDEL MOHAMED  
PATENT EXAMINER  
GROUP 1000  
TC 1660